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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,054	01/16/2004	Fu-Hsien Hsu	14254-43623	1175

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EXAMINER

TON, ANABEL

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

EX

<b>Office Action Summary</b>	<b>Application No.</b> 10/761,054	<b>Applicant(s)</b> HSU ET AL.	
	<b>Examiner</b> Anabel M. Ton	<b>Art Unit</b> 2875	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 16 January 2004.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☒ Claim(s) 18-25 is/are allowed.

6) ☒ Claim(s) 1-5, 8-11 and 15-17 is/are rejected.

7) ☒ Claim(s) 6, 7 and 12-14 is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
       Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
       Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All    b) ☐ Some \*    c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 9-11,15 are rejected under 35 U.S.C. 102(e) as being anticipated by Huang (6,523,978).
3. The recitation “ a decorative illuminated article adapted for use with a lighting string” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).
4. Huang discloses a wiring assembly including a length of wire having a first end and a second end the first end connected a male insert (end of 43), the second end connected to a lighting assembly (50,60), a hollow enclosure (20) including a decorative

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element contained therein (wiring 60 is meant to elastically form decorative shapes, thus fulfilling this limitation), a collar having a hold through which the wire is inserted (22), the collar slidably positioned between the first end and second end (it is assumed that first and second end are referring to that of the wire) the collar having an interior surface adapted to receive the neck (43, fig 4), a threaded gasket positioned around the neck (30); the lighting assembly comprises a plurality of LEDs and a base for supporting the LEDs (50,60).

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang above, and further in view of Blanton (6,109,765).

3. Huang discloses the claimed invention except for the recitation of a clip attached to the wire for receiving a light bulb from the lighting string. Blanton discloses a clip attached to a light string assembly for holding a bulb (abstract, 15, fig 1). As shown by Blanton, the clip is attached to a bulb and subsequently the wiring attached to the bulb. Huang discloses a wiring assembly including a length of wire (42) having a first end and

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a second end the first end connected to a male insert (43) the second connected to a lighting assembly (41,42), a hollow enclosure including a decorative element (wiring 60 is meant to elastically form decorative shapes, thus fulfilling this limitation), the lighting assembly comprises a plurality of LED's and a base for supporting the plurality of LED's (60, 50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the teaching of a bulb holding clip of as taught by Blanton in the device of Huang for the purpose of providing a means for holding a bulb to a desired location.

- Blanton discloses: at least two substantially parallel segments connected at one end and having a circular void there between (16, 20,21); the void dimensioned to receive a light bulb (20, fig 1); the segments are sufficiently flexible to partially and temporarily separate to receive a light bulb within the void (abstract); the first and second segment joined at one end (bottom portion of 15) and a first void and second void formed between the first segment and the second segment (1<sup>st</sup> void 20, 2<sup>nd</sup> void 19);

4. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (5,964,520) and further in view of Yen (5,599,092).

5. Lee discloses the claimed invention except for the recitation of a hollow enclosure. Lee discloses a wiring assembly including a length of wire having (12) a first end and a second end (fig 5), the first end being connected to a male insert (46, fig 5), and second end connected to the lighting assembly (a second end as shown in figure 5 is connected to the lighting assembly as well as the male insert, but is nonetheless

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connected to the lighting assembly) the male insert comprising a base (46, 42,40 (husk), the husk including pair of resilient tabs (22,24) having a fixed end flexibly attached to and extending angularly from opposed sides of the husk in a coaxially aligned spaced apart relation wherein each tab is adapted to deflect in a direction towards the opposed tab upon application of a biasing force and protrude in a direction away from the opposed tab upon removal of the biasing force(figs 3-5). Yen discloses a hollow enclosure including a decorative element contained therein and a neck having an opening sized to be received by a lighting assembly (Fig 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the teaching of a decorative hollow body as taught by Yen over the lighting device of Lee for the purpose of providing Lee with a decorative device adaptable for use with a light string.

With regards to the lighting assembly of Lee having a plurality of LED's, the examiner takes Official Notice that the use of LEDs is old and well known in the illumination art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute an LED for the light source in the system of Lee in combination with Yen. One would have been motivated since LEDs are recognized in the illumination art to have many desirable advantages, including reduced size, high efficiency, low power consumption, long life, resistance to vibrations, and low heat production, over other light sources.

***Allowable Subject Matter***

6. Claims 6,12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art cited does not teach the first void dimensioned to receive a wire and the second void dimensioned to receive a bulb, the collar having ribbing or knurls.

7. Claims 18-25 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art cited, in combination, does not provide sufficient motivation to overcome the limitations as recited in claim 18, including the combination of the wiring assembly as recited with the collar having an interior surface threadably receiving the neck and a clip removably attached to the wire the clip including a circular void dimensioned to receive a light bulb from a lighting string.

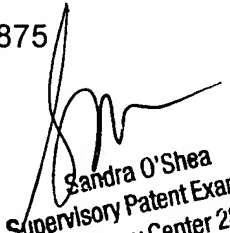
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anabel M. Ton whose telephone number is (571) 272-2382. The examiner can normally be reached on 08:00-16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMT

Anabel M Ton  
Examiner  
Art Unit 2875



Sandra O'Shea  
Supervisory Patent Examiner  
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